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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/923,618	08/07/2001	Fumitake Yodo		1742

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EXAMINER

FISCHER, ANDREW J

ART UNIT

PAPER NUMBER

3627

DATE MAILED: 10/21/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/923,618

Applicant(s)
Fumitake Yodo

Examiner
Andrew J. Fischer

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Jul 23, 2002
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 10-12 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 10-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☒ Certified copies of the priority documents have been received in Application No. 09/600,509.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) ☐ Other:

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DETAILED ACTION

Acknowledgments

1. The amendment filed July 23, 2002 (Paper No. 5) is acknowledged. Accordingly, claims 10-12 remain pending.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 12 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Particularly, the phrase “making a request for purchasing the accounting point information to the accounting center” is unclear. It is believed that Applicant desires to claim making a request for purchasing additional accounting points and not the information. Under the broadest reasonable interpretation and as currently claimed, it appears one is purchasing sales figures (information) and not accounting points. This applies to the “an other” processing as found in claim 12 as well. Appropriate correction is required.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 10-12, as understood by the Examiner, are rejected under 35 U.S.C. 102(b) as being anticipated by Ushiki et. al. (U.S. 5,438,356). Ushiki et. al. discloses the following: storing the accounting information (typing sale data into the computer); the information is from an external source (sale figures); the information is updated (if an error was made or information was incorrect, sales figures are updated); a request is made for the accounting information (in the form of a query and results in a financial report).

6. Functional recitations using the word “for” (e.g. “for communicating with the accounting center” as recited in claim 11) have been given little patentable weight because they fail to add any steps and are thereby regarded as intended use language. A recitation of the intended use of the claimed invention must result in additional steps. See *Bristol-Myers Squibb Co. v. Ben Venue Laboratories, Inc.*, 246 F.3d 1368, 1375-76, 58 USPQ2d 1508, 1513 (Fed. Cir. 2001) (Where the language in a method claim states only a purpose and intended result, the expression does not result in a manipulative difference in the steps of the claim.). Where an intended use is not desired, the Examiner recommends removing “for” from the claims. For example, instead of “for communicating” the Examiner suggests simply --communicating--.

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7. The Examiner notes that Applicant has declined the Examiner's express invitation¹ to be his own lexicographer by indicating and defining claim limitations to have meanings other than their ordinary and accustom meanings.² Accordingly and for due process purposes, the Examiner gives notice that for the remainder of the examination process, the presumption in favor of the ordinary and accustom meaning is maintained and is now made final. The claims are therefore interpreted with their "broadest reasonable interpretation" *In re Morris*, 127 F.3d 1048, 1054, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997).³ The Examiner now relies heavily on this interpretation.⁴

8. The Examiner notes that it is immaterial whether the prior art discloses "decrementing" or "incrementing" since its a scientific truism that the decrementing of a negative number is

¹ See the Examiner's previous Office Action, Paper No. 4, Paragraph No. 7 mailed April 24, 2002.

² See e.g. *In re Thrift*, 298, F.3d 1357, 1364, 63, USPQ2d 2002, 2006 (Fed. Cir. 2002) ("Although an applicant may be his own lexicographer, nothing in the specification defines the phrase 'speech user agent' differently from its ordinary meaning.") (citations omitted).

³ See also MPEP §2111; *In re Graves*, 69 F.3d 1147, 1152, 36 USPQ2d 1697, 1701 (Fed. Cir. 1995); *In re Etter*, 756 F.2d 852, 858, 225 USPQ 1, 5 (Fed. Cir. 1985) (en banc).

⁴ See 37 C.F.R. §1.104(c)(3) which states in part: "the examiner may rely upon admissions by applicant . . . as to *any matter* affecting patentability [Emphasis added.]"

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simply addition.⁵ Since accounting point information could be a negative number (e.g. crediting someone's account), the inclusion of "decrementing" as opposed to "incrementing" is not patentably significant since the prior art disclosure of either "decrementing" or "incrementing" would make the other inherent in the prior art.

9. Regarding first and second memory locations, it is the Examiner's position that these are inherent in any computation device. Different memory addresses sufficient to hold all the claimed data disclose these limitations.

10. Regarding "carrying out an other accounting processing," it is the Examiner's position that this too is inherent. Under the broadest reasonable interpretation standard discussed above, virtually any account processing would meet this limitation. Only if a system performs a *single* account process (which none of the prior art does since they are *all* directed to multiple processes), would this limitation not be met.

11. Furthermore, the Examiner interprets "an other" to mean "another."

Claim Rejections - 35 USC § 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

⁵ $A - B = A + B$.

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having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claims 10-12, as understood by the Examiner, are alternatively rejected under 35 U.S.C. 103(a) as being unpatentable over standard accounting practices. The Examiner notes that the standard accounting functions found in claims 10-12 are admitted prior art (see below). It is indeterminate as to whether the computerization of these steps is old and well known.

If not old and well known, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify standard accounting steps and to automate them with a computer. Providing an automatic means to replace a manual activity which accomplishes the same result is not sufficient to distinguish the claimed invention over the prior art in terms of patentability. See *In re Venner*, 262 F.2d 91, 95, 120 USPQ 93, 94 (CCPA 1958). See e.g. Brown (U.S. 5,875,423) as evidence that automating and accounting system is old and well known in the art.

14. Since Applicant did not seasonably traverse the Official Notice statements as stated in the previous Office Action (Paper No. 4, Paragraph No. 9 mailed April 24, 2002), the Official Notice statements are taken to be admitted prior art. See MPEP §2144.03.

Response to Arguments

15. Applicant's arguments filed July 23, 2002 (part of Paper No. 5) have been fully considered but they are not persuasive.

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16. Applicant argues that “[c]laims 10 and 11 have been amended in part to recite that the accounting point information is stored in a first memory of the terminal device and are submitted to recite structure that cannot be found in Ushiki et al.”⁶

17. First, claims 10-12 are directed to a method which is a process.⁷ Furthermore, “it is generally the rule that patentability of a method claim must rest on the method steps recited, *not on the structure used*, unless that structure affects the method steps. [Emphasis added.]” *Leesona Corp. v. US*, 530 F.2d 896, 908 (US Ct Clms 1976). Additionally, “[t]o be entitled to such [patentable] weight in method claims, the recited structural limitations therein must affect the method in a manipulative sense and not to amount to the mere claiming of a use of a particular structure” *Ex Parte Pfeiffer*, 135 USPQ 31, 33 (B.P.A.I. 1961). In this case, it is the Examiner’s position that the recited structure does not affect the method steps in a manipulative sense because the steps of “storing” and “updating” can be implement on virtually any computing device.

18. Applicant further argues that “we see that the accounting system, not the terminal, stores the accounting information and calculates a fee”⁸ First this argument is immaterial to claim 11 because claim 11 does not specify where the information is stored. Regarding claims 11 and

⁶Applicant’s Remarks Filed July 23, Paper No. 5 (“Remarks 5”), page 5, approximately lines 18-21 .

⁷ See 35 U.S.C. 100(b) (“The term ‘process’ means process, art, or method,”).

⁸ Remarks 5, pages 5-6.

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12, Applicant's have expressly claimed their method in a system (see e.g. claim 11, "A data processing method in an accounting system . . ."). Therefore, because the scope of Applicant's method claim is within a system, the prior art "system" anticipates since it makes no difference as to which sub-units of the prior art system the claimed features are found.

Conclusion

19. Applicant's amendment necessitated the new ground(s) of rejection (if any) presented in this Office Action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

20. Because this application is now final, Applicant is reminded of USPTO's after final practice as discussed in MPEP §§714.12 and 714.13 and that entry of amendments after final is

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not a matter of right. Furthermore, suggestions or examples of claim language provided by the Examiner are just that—suggestions or examples—and do not constitute a formal requirement mandated by the Examiner. Unless stated otherwise by an express indication that the claim is “allowed,” exemplary claim language provided by the Examiner to overcome a particular rejection or to change claim interpretation has *not be addressed* in comparison to other aspects of patentability (e.g. §101 patentable subject matter, §112 2nd paragraph antecedent basis and indefiniteness, and §§102 and 103 prior art). Therefore, any claim amendment that incorporates an Examiner suggestion or example or simply changes claim interpretation will nevertheless require further consideration and/or search and a patentability determination as noted above.

21. All MPEP sections cited within are from the Manual of Patent Examining Procedure (MPEP) Eighth Edition, August 2001 unless expressly noted otherwise.


22. In accordance with the USPTO’s goals of customer service, compact prosecution, and reduction of cycle time, and because “the continual, chief complaint of inventors and their lawyers: that patent examiners are abysmal communicators, both orally and in writing,”⁹ the Examiner has made every effort to clarify his position regarding claim interpretation and any rejections or objections in this application. Furthermore, the Examiner has again provided Applicant with notice—for due process purposes—of his position regarding his factual determinations and legal conclusions. The Examiner notes Applicant’s “Remarks” traversing the

⁹ Sabra Chartrand, *A Bid to Overcome Patent Backlogs*, 152 N.Y. Times C2 (Sept. 23, 2002).

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Examiner's positions on various points. If Applicant disagrees with *any* additional factual determination or legal conclusion made by the Examiner in this Office Action whether expressly stated or implied¹⁰, the Examiner respectfully requests Applicant *in his next properly filed response* to expressly traverse the Examiner's position and provide appropriate arguments in support thereof. By addressing these issues now, matters where the Examiner and Applicant agree can be eliminated allowing the Examiner and Applicant to focus on areas of disagreement (if any) with the goal towards allowance in the shortest possible time. If Applicant has *any* questions regarding the Examiner's positions or has other questions regarding this communication or even previous communications, Applicant is strongly encouraged to contact Examiner Andrew J. Fischer whose telephone number is (703) 305-0292.


ANDREW J. FISCHER
PATENT EXAMINER

 10/21/02
ROBERT P. OLSZEWSKI
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AJF
October 19, 2002

¹⁰ E.g., if the Examiner rejected a claim under §103, although not directly stated, it is the Examiner's implied position that the references are analogous art.